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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,175	07/23/2003	Masato Hatayama	ALPSP129	1458
22434	7590	06/01/2004		
BEYER WEAVER & THOMAS LLP P.O. BOX 778 BERKELEY, CA 94704-0778			EXAMINER EASTHOM, KARL D	
			ART UNIT 2832	PAPER NUMBER

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,175

Applicant(s)

HATAYAMA, MASATO

Examiner

Karl D Easthom

Art Unit

2832

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/23/3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 2832

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 4-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Taguchi et al.
al. Taguchi discloses the claimed invention with first layer 2 having carbon black and fiber reinforcing material in a binder resin, and second layer 3 having carbon black and reinforcing material (fibers) in a binder resin. The claim is not clear as to which layer contacts the slider. Hence, the claim is interpreted such that the “lower layer” in Fig. 7 is the second layer of the claim, which is on the “upper” layer, where “on” means touching. Also, note that either layer can be “on” the other layer when the device is flipped upside down, for example, such as when it is on a circuit board or otherwise mounted or carried in an upside down manner from which it is normally viewed. For claims 4-5 see the table at Fig. 7, while for claim 6, “pulverize” means to grind, and the powder is ground at col. 5, lines 45-40.

Art Unit: 2832

4. Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hatayama et al. Hatayama et al. discloses the claimed invention with first layer 2 having carbon black 4 and fibers 1 (reinforcing material) in a binder resin, and second layer 3 having carbon black 4, some of which is a reinforcing material of the claim, since the claim does not require the two to be different. Also, the graphite is a reinforcing material, noted at col. 3, lines 10-20, or the other forms of carbon black - furnace black, acetylene black channel black, or graphite are smaller than the reinforcing material of fibers 1 as depicted at Fig. 1, or as evidenced by the problem noted of carbon fibers sticking in the screen, or by the evidence of the graphite as flaky or slurry, col. 3, lines 10-20. For claim 4, the amount of the carbon black in the second layer is the same as that in the first layer, as noted at col. 3, lines 30-57, and is from 5-25%, so that if 5% is deemed the carbon black of the claim, the other 20% is the volume of the second reinforcing material. For claim 5, the diameter of 6-20um at col. 2, lines 45-65, meets the claim. For claim 6, pulverize means to reduce to powder, and the first layer has carbon black powder 4, some of which meets the claim as a reinforcing material, where there is no evidence that powder produced from pulverized fiber is structurally distinct from any other type of carbon powder, since it is all a carbon powder.

5. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taguchi et al. in view of Komatsu et al. The claimed invention is disclosed except the size and shape of the material. Komatsu discloses particles of approximately in the range from 1-3um at example 2, made by a ball mill, and noted to be ground so that it is granular, thus disclosing or suggesting spherical particles, where granular means made of granules which are pellets, and pellets are typically spherical, and the shape is suggested at col. 2, lines 54-63, so that there is no

Art Unit: 2832

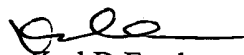
anisotropic conductivity adversely effecting in the resistor, so that same would have been obvious.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl D Easthom whose telephone number is (571) 272-1989.

The examiner can normally be reached on M-Th, 5:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on (571) 272-1990. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Karl D Easthom
Primary Examiner
Art Unit 2832

KDE